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## NOTICE OF ALLOWANCE AND FEE(S) DUE

22201 7590 02/25/2004

WESTERLUND & POWELL  
122 N ALFRED STREET  
ALEXANDRIA, VA 223143011

EXAMINER

OH, TAYLOR V.

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 02/25/2004

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,413	12/06/2001	Neil W. Boaz	011927-113100	8373

TITLE OF INVENTION: PREPARATION OF SUBSTITUTED AROMATIC CARBOXYLIC ACID ESTERS

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1330	\$300	\$1630	05/25/2004

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN **THREE MONTHS** FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. **THIS STATUTORY PERIOD CANNOT BE EXTENDED.** SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

### HOW TO REPLY TO THIS NOTICE:

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If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

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If the SMALL ENTITY is shown as NO:

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B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check the box below and enclose the PUBLICATION FEE and 1/2 the ISSUE FEE shown above.

☐ Applicant claims SMALL ENTITY status.  
See 37 CFR 1.27.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

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**IMPORTANT REMINDER:** Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,413	12/06/2001	Neil W. Boaz	011927-113100	8373

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APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1330	\$300	\$1630	05/25/2004

EXAMINER	ART UNIT	CLASS-SUBCLASS
OH, TAYLOR V	1625	560-020000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

- ☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.
- ☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.

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(A) NAME OF ASSIGNEE (B) RESIDENCE: (CITY and STATE OR COUNTRY)

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- ☐ Payment by credit card. Form PTO-2038 is attached.
- ☐ The Director is hereby authorized by charge the required fee(s), or credit any overpayment, to Deposit Account Number \_\_\_\_\_ (enclose an extra copy of this form).

Director for Patents is requested to apply the Issue Fee and Publication Fee (if any) or to re-apply any previously paid issue fee to the application identified above.

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NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Alexandria, Virginia 22313-1450.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,413	12/06/2001	Neil W. Boaz	011927-113100	8373
22201	7590	02/25/2004	EXAMINER	
WESTERLUND & POWELL 122 N ALFRED STREET ALEXANDRIA, VA 223143011			OH, TAYLOR V	
			ART UNIT	PAPER NUMBER
			1625	
DATE MAILED: 02/25/2004				

## Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 109 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 109 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) system (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (703) 305-1383. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.

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**Notice of Allowability**

Application No.

10/004,413

Examiner

Taylor Victor Oh

Applicant(s)

BOAZ ET AL

Art Unit

1625

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address—

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 12/19/03.
2. ☒ The allowed claim(s) is/are 22-35 as renumbered as claims 1-14.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☒ Certified copies of the priority documents have been received in Application No. 09/288,642.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

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**Examiner's Amendment and Reasons of Allowance**

I. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with an attorney of record, Mr. Jeffrey Townes on 2/20/2004.

II. The application has been amended as follows:

In the line 8 on page 5 of the specification, the phrase "-- a C<sub>4</sub>-C<sub>10</sub> aryl or heteroaryl --" before the word "an ether" has been deleted and replaced with the phrase "a C<sub>6</sub>-C<sub>10</sub> aryl or C<sub>4</sub>-C<sub>10</sub> heteroaryl".

In the line 3 on page 10 of the specification, the phrase "-- a C<sub>4</sub>-C<sub>10</sub> aryl or heteroaryl group--" before the word "containing" has been deleted and replaced with the phrase "a C<sub>6</sub>-C<sub>10</sub> aryl or C<sub>4</sub>-C<sub>10</sub> heteroaryl group".

In claim 25, line 5 on page 3 (CLMSPTO on 12/19/03):

the phrase "-- a C<sub>4</sub>-C<sub>10</sub> aryl or heteroaryl group before the word "an ether" has been deleted and replaced with "a C<sub>6</sub>-C<sub>10</sub> aryl or C<sub>4</sub>-C<sub>10</sub> heteroaryl group".

In claim 30, line 3 on page 4 (CLMSPTO on 12/19/03):

the phrase "-- a C<sub>4</sub>-C<sub>10</sub> aryl or heteroaryl group before the word "and" has been deleted and replaced with "a C<sub>6</sub>-C<sub>10</sub> aryl or C<sub>4</sub>-C<sub>10</sub> heteroaryl group".

In claim 33, line 4 on page 5 (CLMSPTO on 12/19/03):

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the phrase "— a C<sub>4</sub>-C<sub>10</sub> aryl or heteroaryl group before the word " an ether " has been deleted and replaced with "a C<sub>6</sub>-C<sub>10</sub> aryl or C<sub>4</sub>-C<sub>10</sub> heteroaryl group" .

III. The following is an examiner's statement of reasons for allowance:

- The rejection of Claims 22, 29, 31 and 35 under 35 USC 112, first paragraph, has been withdrawn due to applicants' convincing argument in the amendment.
- The rejection of Claims 24-25, 30, 31 and 33 under 35 USC 112, second paragraph, has been withdrawn due to applicants' convincing argument and amendment in the response.
- The close prior art to the current invention are Heck (U.S. 3,988,358) , Suto et al (U.S. 5,296,601) , and Wehrenberg (U.S. 4,704,467)

Heck teaches a process of producing carboxylic acid esters by reacting aryl, heterocyclic, or benzylic halides or various substituted derivatives including a nitro group, an alkyl, or substituted halogen groups with carbon monoxide and an alcohol, such as

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Art Unit: 1625

methanol, ethanol, propanol, and etc. in the presence of a homogeneous palladium catalyst and a tertiary amine.

Suto et al teaches a process of producing carboxylic acid esters by reacting an organic chloride represented by  $R^1Cl_m$ , where  $R^1$  is a substituted or unsubstituted aromatic or heterocyclic hydrocarbon group and  $m$  is an integer of 1 or more, with  $R^4OH$ , where  $R^4$  is a substituted or unsubstituted aliphatic, aromatic or heterocyclic hydrocarbon group, carbon monoxide in the presence of a homogeneous catalyst containing palladium compound, such as metallic palladium, palladium carbon and a phosphine compound catalyst and a tertiary amine.

Wehrenberg teaches a method of preparing mercaptobenzoates by reacting nitro-substituted aromatic carboxylic acid ester with a mercaptan ( $R-SH$ ) (see from col. 1 line 55 to col. 2, line 14) in the presence of an inorganic base, such as potassium carbonate or sodium carbonate and non-polar aprotic solvents, such as benzene, tetrahydrofuran, diethyl ether, and a phase transfer catalyst including tetra-lower alkyl substituted ammonium and phosphonium halides.

The instant invention, however, differs from the prior art in that the claimed metal catalyst is the heterogeneous catalyst of palladium metal deposited on activated carbon; none of them teach the use of the heterogeneous catalyst of palladium metal deposited on activated carbon; furthermore, Wehrenberg does not teach the following elements of Applicants claimed process: the intermediate reactions, carbon monoxide, alcohol, proton acceptor, and a heterogeneous catalyst of palladium metal on carbon,

thereby failing to cure the deficiencies of Heck and Suto. In addition, unless all limitations of the claims are met, there is no prior art rejection. See In re Zurko 59 USPQ 2d 1690 (Fed Cir. 1991) and In re Lee, 61 USPQ 1430 (Fed Cir. 1991).

Therefore, the claimed invention would not have been obvious to the person with an ordinary skill in the art.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning the communication after allowance such as sending all post-allowance correspondence should be directed to " Box Issue Fee" or faxed directly to PUBS at 703-305-8755. This will expedite the process of these papers.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 1625

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*Myr J Sh*  
*2/20/04*

*Bernard D. [Signature]*

BERNARD D. [Signature]  
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